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10/802,401	03/17/2004	Achim Hartlaub	82448	3701

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FITCH EVEN TABIN AND FLANNERY
120 SOUTH LA SALLE STREET
SUITE 1600
CHICAGO, IL 60603-3406

EXAMINER

LUONG, VINH

ART UNIT	PAPER NUMBER
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3682

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/28/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/802,401

Applicant(s)

HARTLAUB ET AL.

Examiner

Vinh T. Luong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-20 is/are pending in the application.
- 4a) Of the above claim(s) 7 and 8 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4 is/are allowed.
- 6) ☒ Claim(s) 2,3 and 9-20 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.


Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/17/04 & 11/25/05 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


Vinh T. Luong
Primary Examiner

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☒ Other: Attachment

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1. The Amendment filed on December 19, 2006 has been entered.
2. Claims 7 and 8 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on April 8, 2005.
3. The drawings were received on November 25, 2005. These drawings are not accepted by the Examiner because of the objection under 37 CFR 1.83(a) below.
4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed feature(s) such as the adhesive in claim 3 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will

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be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The disclosure is objected to because of the following informalities: each part of the invention, such as, the adhesive in claim 3 and the interspace in claim 4 should be designated by a referential numeral or character. Appropriate correction is required.

6. Claim 3 is objected to because of the following informalities: the claim has typographical or grammatical error, e.g., “adhesive” should have been changed to “an adhesive.” Appropriate correction is required.

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 2, 5, 9, 12, 13, and 15-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Miyako et al. (US Patent Publication 2002/0033321 A1 cited by Applicant from the Office action of Japanese Patent Office).

Regarding claim 16, Miyako teaches a steering wheel 1 for mounting of a build-on part 3 (FIG. 3) thereon, the steering wheel 1 comprising:

- a steering wheel skeleton 11;

- foam material 22 (FIGS. 3 and 4) surrounding the skeleton 11;

- a holding part 21 that is fixed relative to the skeleton 11 by the foam material 22 so that a first portion (unnumbered at 23 in FIG. 4. See Attachment hereinafter “Att.”) of the holding part 21 is fixed within the foam material 22 against removal therefrom and a second portion 21b (FIG. 4) of the holding part 21 projects therefrom for mounting of the build-on part 3 thereto. See Attachment and Miyako’s claims 1-5.

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Regarding claim 2, the holding part 21 bears against the steering wheel skeleton 11 as shown in FIG. 4.

Regarding claim 5, the holding part 21 surrounds the steering wheel skeleton 11 at least partially at one point (see FIG. 4 of Att.).

Regarding claim 9, the holding part 21 is adjacent a spoke 1c (FIG. 3) of the steering wheel 1.

Regarding claim 12, the build-on part 3 comprises an adaptor 6 (FIG. 1), which is connected to the holding part 21 and allows an additional build-on part 5 to be connected thereto. See paragraph [0027].

Regarding claim 13, the adaptor 6 is an adaptor plate 6.

Regarding claim 15, the first portion (unnumbered in FIG. 4. See Att.) of the holding part 21, which lies within the steering wheel foam, surround 22 has a smaller longitudinal extent than the (second) portion 21b (Att.), which lies outside the steering wheel foam surround 22.

Regarding claim 17, the skeleton 11 is free of drilled openings for receiving fasteners for supporting the holding part 4, 9 in substantially fixed relation thereto. See paragraph [0031].

Regarding claim 18, the first portion (unnumbered at 23 in FIG. 4. See Att.) is spaced from the skeleton 11 and embedded in the foam material 22 to be surrounded thereby.

Regarding claim 19, the foam material 22 provides the only holding force between the holding part 21 and the skeleton 11 as seen in FIG. 1.

Regarding claim 20, the skeleton 11 and the holding part 21 (FIG. 4) inherently have predetermined substantially fixed positions relative to each other via molding of the foam

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material 22 to surround the skeleton 11 with the skeleton 11 and the holding part 21 in the predetermined substantially fixed positions as shown in FIGS. 3 and 4.

9. Claims 3, 10, 11, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyako et al.

Regarding claim 3, Miyako teaches the invention substantially as claimed. However, Miyako does not explicitly teach the adhesive between the holding part 21 and the skeleton 11 for adhesively bonding the holding part 21 to the skeleton 11.

It is common knowledge in the art to use the adhesive for bonding Miyako's holding part 21 to Miyako's skeleton 11 in order to improve the stable mounting of the build-on part (switch) 3 on the steering wheel. The use of adhesive bonding as a fastening means in lieu of bracket or screw is notoriously well known. See, e.g., column 3, lines 60-65 of US Patent No. 6,354,622 B1 issued to Ulbrich et al.; column 3, lines 7-9 of US Patent No. 6,418,814 B1 issued to Emeneth et al.; and column 2, line 1 of US Patent No. 6,889,436 B2 issued to Derrick. In addition, it is well settled that the patentability of a product does not depend on its method of production, such as, adhesive bonding. *In re Thorpe*, 227 USPQ 964, 966 (CAFC 1985); *In re Brown*, 173 USPQ 685 (CCPA 1972); *In re Fessmann*, 180 USPQ 324 (CCPA 1974); *Ex parte Edwards*, 231 USPQ 981 (BPAI 1986); and MPEP 2113.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use adhesive for bonding Miyako's holding part to Miyako's skeleton in order to improve the stable mounting of the build-on part (switch) on the steering wheel as taught or suggested by common knowledge in the art.

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Regarding claims 10 and 11, Miyako teaches the invention substantially as claimed. However, Miyako does not explicitly teach the material of which the holding part 21 is made. On the other hand, Miyako teaches the well known material such as metal or plastic as evidenced by the metal core 11 and plastic casing 4 in, e.g., paragraphs [0021] and [0022] in order to reduce the cost of manufacturing.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to choose the well known material such as metal or plastic as the material for Miyako's holding part in order to reduce the cost of manufacturing as taught or suggested by Miyako. See *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960) and MPEP 2144.07.

Regarding claim 14, Miyako teaches the invention substantially as claimed. However, Miyako's holding part 21 is not connected to the build-on part 3 by means of screws or rivets.

It is common knowledge in the art to use the screws or rivets in order to connect the holding part to the build-on part as evidenced by Miyako's description in paragraphs [0002] and [0003].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the screws or rivets in order to connect Miyako's holding part to the build-on part as taught or suggested by common knowledge in the art.

10. Claim 4 is allowed.

11. Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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12. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

13. Applicant's arguments filed December 19, 2006 have been fully considered but they are not persuasive.

At the outset, Applicant contended that Miyako teaches two embodiments, one shown in FIGS. 1 and 2 and the other shown in FIGS. 3 and 4, neither of which show a holding part that is fixed to the steering wheel skeleton by foam material as recited in claim 16. See page 6 of the amendment.

The Examiner *sua sponte* withdraws the rejection based on Miyako's first embodiment of FIGS. 1 and 2 to simplify the issues. The instant final rejection is based on Miyako's second embodiment of FIGS. 3 and 4 only.

Applicant asserted, *inter alia*, that "it is clear that the foam material 22 does not hold the switch 3. Rather it is the engagement of the hooks 21 and specifically the end projections 21b thereof against the core metal 11 of the steering wheel that keep the switch 3 from being pulled out of the hole 23 in the foam material 22 and the aligned hole 24 in the core metal 11." See second paragraph on page 7 of the amendment.

The Examiner respectfully submits that Applicant's assertion is unsupported by substantial evidence in the record. It is clear that the foam material 22 does hold the switch 3 as best shown in FIG. 4 and Miyako's description in paragraphs [0028] and [0029] quoted below:

As shown in FIG. 4, hole portions 23 and 24 are formed correspondingly to each of *the mounting hooks 21* of the switch 3 in such a manner as to be aligned with each other and as to *penetrate the soft material 22* and the core metal. Furthermore, a

*retaining portion 25 is formed like a plate and is provided on the inner surface of the lower cover 12 correspondingly to each of the mounting hooks 21 of the switch 3 in such a way as to **extend** in a direction perpendicular to the corresponding mounting hook 21 and as to be tapered toward the tip end thereof.*

Thus, in the case of the second embodiment, each of the mounting hooks 21 is inserted into the hole portions 23 and 24 from the front side of the switch 3 (that is, from above, as viewed in these figures), and then the hook projection 21b thereof is engaged with a back side peripheral part of the hole portion 24. Further, when the lower cover 12 is attached to the switch 3 in this state, each of the retaining portions 25 is inserted into a space provided between the leg portions 21a of a corresponding one of the mounting hooks 21 from the back side of the switch 3 (that is, from below in these figures). Thus, each of the retaining portions 25 comes in contact with the inner side surface of each of the leg portions 21a of the corresponding mounting hook 21 and restrains the corresponding mounting hook 21 engaged with the core metal 11 from moving in a direction in which the engagement between this mounting hook 21 and the core metal 11 is canceled. Consequently, *this embodiment prevents the mounting hooks 21 from disengaging from the core metal 11, and serves to mount the switch 3 on the steering wheel 1.* (Emphasis added).

As quoted above, when the hook/holding part 21 is inserted into the holes 23 and 24 and when the plate 25 is inserted into the space provided between the second portion 21a of the holding part 21, the first portion of the holding part 21 shown in the Attachment is extended against the foam 22. Consequently, the first portion of the holding part 21 is press-fitted or frictionally fixed with the foam 22. It is clear that the frictional force between the foam material 22 and the first portion of the holding part 21 holds the part 21 to the foam 22 or *vice versa*. Since the holding part 21 is a component of the switch 3 as shown in FIG. 3, *a fortiori*, the frictional force between the foam material 22 and the first portion of the holding part 21, in turn, holds the switch 3 to the foam 22 or *vice versa* and serves to mount the switch 3 on the steering

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wheel 1 without the need of a bracket or a screw as pointed out in Miyako's Background of the Invention and Summary of the Invention.

Applicant further contended that the mounting hooks 21 of the outer casing 4 are part of the switch 3 which corresponds to the recited build-on part and not the recited holding part as contemplated in claim 16. See last paragraph on page 7 of the amendment.

The Examiner respectfully submits during patent examination, the pending claims must be given their *broadest reasonable interpretation consistent with the specification*, however, it is impermissible to import the subject matter from the specification into the claims. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1320 (Fed. Cir. 2005) *en banc* and MPEP 2111. In addition, Applicant's arguments are not based on the limitations appearing in the claims. *In re Self*, 213 USPQ 1, 5 (CCPA 1982). It is noted that the features upon which applicant relies (*i.e.*, the build-on part such as a switch can be fixed to a *separate* holding part) are not recited in claim 16. Since claim 16 does not specifically require the build-on part and the holding parts to be *separate* parts, therefore, Applicant's contentions regarding the separate parts are immaterial to the patentability of the claim at issue.

With respect to claim 3, on the one hand, Applicant does not show the claimed adhesive, on the other hand, the adhesion is one of the methods to attach the holding part and the skeleton. It is well settled that the patentability of a product does not depend on its method of production. *In re Thorpe* and MPEP 2113, *supra*. Therefore, the adhesion in claim 3 would not import patentability to the product or apparatus claim 3.

With respect to claim 6, the Examiner agrees that claim 6 is patentable over the art cited.

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Based on the foregoing, the Examiner respectfully submits that the instant case is not in the condition for allowance.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 571-272-7109. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on 571-272-6917. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Luong

February 26, 2007



Vinh T. Luong
Primary Examiner

ATTACHMENT

FIG 3

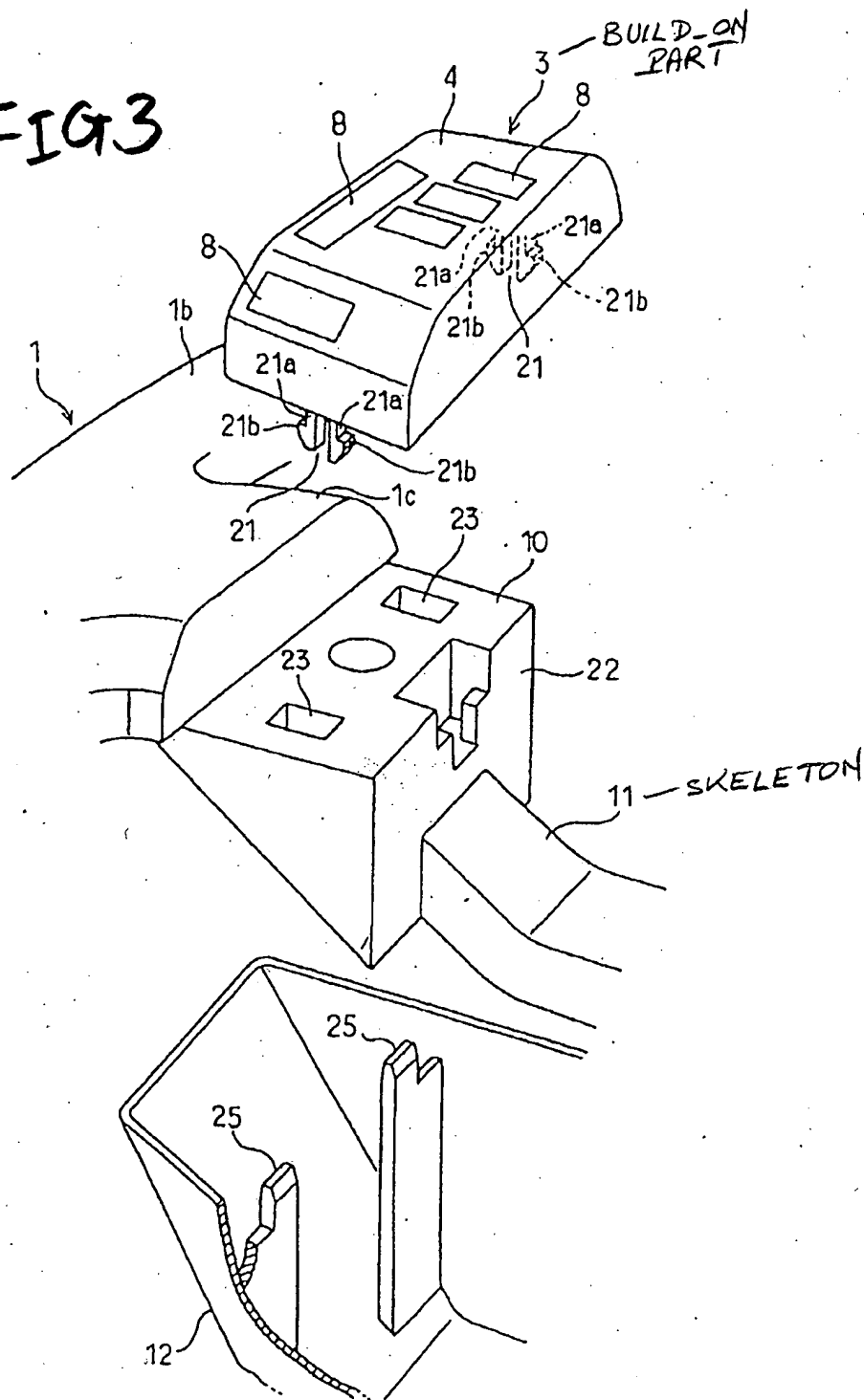


FIG. 4

